

REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

In the referenced Advisory Action dated November 15, 2007 the Examiner did not enter Applicants' Ninth Supplementary Response dated 11-6-2006. The Examiner states the "Remarks/Exhibits have not been considered as such were not timely filed. See 37 C.F.R. § 41.33 and MPEP 1206 ..."

37 C.F.R. § 41.33 states:

§ 41.33 Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to § **41.31**(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § **41.37** may be admitted as provided in § **1.116** of this title.

Since the Appeal Brief was filed 12-01-2006 and the Ninth Supplementary Response was filed 11-6-2006, the Ninth Supplementary Response "may be admitted as provided in § **1.116**" of 37 C.F.R.

37 C.F.R. § **1.116** states:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ **1.113**) in an application ... but before or on the same date of filing an appeal (§ **41.31** or § **41.61** of this title), may be

admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

Applicants respectfully request that Ninth Supplementary Response dated 11-6-2006 be entered or this Seventeenth Supplementary Response be interred. The following is “a showing of good and sufficient reasons why [this] ... evidence is necessary and was not earlier presented.”

The attachment of the Ninth Supplementary Response and of this Seventeenth Supplementary Response are directed to a definition of a BSCOO material which the Examiner referred to at page 8 of the Final Action but did not define and which was well know to persons of ordinary skill in the art prior to Applicants' invention and is information that is know of should be known to the Examiner of the present application. An Examiner of a patent application handles a narrower filed of technical subject matter than a panel of the Board of Appeals that reviews an applicant's appeal. Applicants submitted the Ninth Supplementary Response and this Seventeenth Supplementary Response to provide the panel of the Board of Appeals reviewing this appeal basic knowledge known to persons of ordinary skill in the art and which is know or should be know to the Examiner. Applicants believe that this basic information is necessary since it will asset the Board in rendering a fair and equitable decision. This information was not earlier presented since the Examiner first referred to a BSCOO material in the Final Action. Information well know to persons of skill in the art does not have to be provided in a patent application nor during prosecution unless it is requested by the Examiner or is necessary to respond to an issue that arises during prosecution. What the definition is of a BCOO material arose during prosecution in the Final Action.

The Examiner states at page 8 of the Final Action

What is not a "matter of routine experimentation" in this complex, unpredictable art is arriving at superconductive compositions outside the scope of the allowable claims (e.g., subsequently discovered BSCCO or TI-systems as disclosed in Rao (see response filed 3/8/05, pages 141-143). The Examiner respectfully maintains that the instant disclosure has not provided sufficient guidance to produce such materials.

A BSCCO compound is an acronym for a Bi-Sr-Ca-Cu-O compound. i.e. a bismuth-strontium-calcium-copper oxide compound. See article attached herewith from the on-line Wikipedia Encyclopedia.

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Respectfully submitted,

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